

Appl. No.: 10/691,841
Amendment July 18, 2007
Reply to Office Action of May 18, 2007

REMARKS/ARGUMENTS

The Office Action of May 18, 2007, has been carefully reviewed and these remarks are responsive thereto. Claims 1, 10, 17, 21, 24, 28, 31, and 36 have been amended, no claims have been cancelled, and no new claims have been added. Claims 1-55 thus remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

Rejections Under 35 U.S.C. § 101

Claims 1-55 stand rejected under 35 U.S.C. 101 because the bodies of claims 1, 10, 17, 24, 31, and 36 are non statutory because they allegedly lack a real world useful result. Applicants respectfully disagree that the rejected claims lack a real world useful result; however, because the rejected claims have been amended into a more preferred form, Applicants respectfully contend the rejection is traversed for at least the following reasons.

Claims 1, 10, 17, 24, 31, and 36 have been amended and include the similar inventive feature where "the one or more virtual folders are configured to be manipulated by an action of at least the sharer, said manipulation is at least one of dragging, copying, and pasting." The manipulation of the one or more virtual folders by an action of at least the sharer is a real world useful result. This manipulation produces a result tied to the physical world.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-55 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Appl. Publ. No. US 2003/0225796 A1 to Matsubara (hereinafter *Matsubara*) in view of U.S. Patent Appl. Publ. No. 2003/0028610 A1 to Pearson et al. (hereinafter *Pearson*).

Claims 1, 7, 14, 24, 31, and 36 have been amended to include the similar inventive feature of "determining the format of the list to be shared to the sharee, wherein the format is one of a static list and a dynamic list." Neither *Matsubara* nor *Pearson*, either alone or in any combination thereof, teach or describe this inventive feature.

Matsubara describes a peer-to-peer file sharing system that allows users to manipulate the contents of a virtual directory contained on a server by adding/deleting subdirectories and file links, which are physically located on a plurality of user-computers. The reference does not

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teach or suggest that the directory (or item lists) can be determined by the sharer's computer to be shared in different formats, such as a static list format or a dynamic list format, as claimed. *See, e.g., Matsubara*, Abstract. In fact, *Matsubara* describes only a limited set of system procedures, including, exhaustively: browsing directories, downloading files, creating directories, registering files, creating file links, deleting directories, de-registering files, deleting file links, and deleting distribution files. *Matsubara*, paragraphs 52-61.

Furthermore, *Pearson* fails to remedy the noted deficiencies of *Matsubara*. *Pearson* describes a file sharing system where queries generate a host list, which lists the host computers containing the desired user-selected file. *See, e.g., Pearson*, Abstract. The reference does not teach or suggest that the directory (or item lists) can be determined by the sharer's computer to be shared in different formats, such as a static list format or a dynamic list format, as is one of Applicants' inventive features. *Pearson*, paragraph 53. Instead, *Pearson* describes sharing files within directories through check boxes and an option that allows a user to "select all files" in a particular directory. *Id.* Thus, because *Matsubara* and *Pearson*, either alone or in any combination thereof, do not teach or suggest all of Applicants' inventive features, claims 1, 7, 14, 24, 31, and 36 are allowable for at least these reasons.

Dependent claims 2-4, 8-9, 11-12, 15-16, 18-19, 22-23, 25-26, 29-30, 33-35, 37-39, and 43-55, which each depend from at least one of claims 1, 7, 14, 24, 31, and 36, are allowable for at least the same reasons as their respective base claim, as well as based on the additional features recited therein.

Dependent claims 5-6, 13-14, 20-21, 27-28, 32, and 40-42 all reference the inventive feature of a dynamic list. The Communication clearly and correctly notes that *Matsubara* does not teach a dynamic list. Office Action, page 5, lines 10-11. However, the Office Action alleges that *Pearson* teaches returning a list of files as a dynamic list. Applicants respectfully disagree that *Pearson* teaches or suggests the sharing of files in dynamic lists. *Pearson* describes a system where the list of shared files can be re-permissioned by the user. *Pearson*, paragraphs 51-57. For example, a file can be removed from the shared list by "right-clicking on that file in the shared file list pane and selecting from the context menu that then appears, the 'remove share' command." *Pearson*, paragraph 56.

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Thus, *Pearson* never discloses or suggests a dynamic list. *Pearson* merely describes the ability of enabling a user to re-permission items such that the items are added or removed from the shared list. Dynamic lists, which provide a more robust feature-set than merely allowing a user to re-permission a file, are discussed at length in the instant application. For example:

If any items in the dynamic list have their properties changed such that they no longer meet the criteria of the dynamic list, then these items are appropriately re-permissioned. In the same way, if any items that do not belong to the dynamic list change such that they fall into the scope and meet the criteria of the dynamic list, they are also re-permissioned to grant access to the users with which the dynamic list is shared.

Specification, page 4, line 22 to page 5, line 2. Thus, since neither *Matsubara* nor *Pearson*, nor the proposed combination of the two, teaches or suggests a “dynamic list,” as recited in claims 5-6, 13-14, 20-21, 27-28, 32, and 40-42, these claims are not obvious under 35 U.S.C. § 103(a) in view of *Matsubara* and *Pearson*.

With respect to claims 43, 45, and 47, neither *Matsubara* nor *Pearson* teaches an order for a list of shared items. The Office Action alleges that *Matsubara* teaches “defining within the list an order of the plurality of referenced items.” Office Action, page 27, lines 7-8. Applicants respectfully disagree. *Matsubara* never discloses an “ordered list of rules.” Indeed, the terms “order” and “ordered” are never found in *Matsubara*. Further, even if *Matsubara* had disclosed an ordered list of rules, it would still not teach an order for the shared items themselves. Thus, since neither *Matsubara* nor *Pearson*, nor the proposed combination of the two, teaches or suggests a “defining within the list an order,” as recited in claim 43, or “a predefined order of the referenced items,” as recited in claims 45 and 47, these claims are not obvious under 35 U.S.C. § 103(a) in view of the cited references.

Matsubara and Pearson Teach Away From Each Other

There is no reasonable basis to combine *Matsubara* with *Pearson*. The Office Action’s motivation is not a motivation to combine references, but rather is the conclusion the examiner has apparently reached after having benefited from reading Applicants’ own disclosure, and is thus impermissible hindsight. In fact, the teachings of *Matsubara* and *Pearson* are clearly divergent and implicitly teach away from one another. To add *Matsubara*’s system server to *Pearson*, and

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to require all sharers and sharees to first interact with the system server before accessing their P2P counterpart, as does *Matsubara*, would defeat the intended purpose of *Pearson's* decentralized P2P file sharing system. See *Pearson*, Figure 1. Similarly, to add the shared file list on the sharer's computer of *Pearson* to the *Matsubara* system would necessarily create redundant lists, one centralized virtual directory on the system server and a corresponding list on each sharer's computer, specific to particular user-selected files and built through querying the plurality of P2P hosts. These redundant lists would seemingly serve no purpose, and would only hinder *Matsubara's* stated goal of simplified sharing in a P2P system. *Matsubara*, paragraph 0009. Accordingly, withdrawal of the § 103(a) rejections of claims 1-55 is respectfully requested.

CONCLUSION

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

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Dated this 17th day of August, 2007

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